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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,826	07/23/2003	Darrell Orvin Wagner	GUID.619PA	8949
51294	7590	01/29/2009	EXAMINER	
HOLLINGSWORTH & FUNK, LLC			PRONE, CHRISTOPHER D	
8009 34TH AVE S.			ART UNIT	PAPER NUMBER
SUITE 125			3738	
MINNEAPOLIS, MN 55425				
MAIL DATE		DELIVERY MODE		
01/29/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARRELL ORVIN WAGNER and JASON ALAN SHIROFF

Appeal 2008-5407
Application 10/625,826
Technology Center 1600

Decided: January 29, 2009

Before TONI R. SCHEINER, DEMETRA J. MILLS, and RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE

The following claim is representative.

1. A dissection tool, comprising:
 - a handle having a proximal end and a distal end;
 - an elongated dissecting member having a proximal end and a distal end, the elongated dissecting member extending from the distal end of the handle; and
 - a light source provided at the distal end of the dissecting member, the light source adapted to provide a visible locating reference through the skin.

Cited References

Chen et al. US 5,445,608 Aug. 29, 1995

Grounds of Rejection

1. Claims 1-5, 8-11, 44, 46, 47, 49, 50, 53-58, and 61-63 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Chen. We select claim 1 as representative of the rejection before us since Appellants have not separately argued the claims. 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The Examiner finds that Chen teaches each element claimed, including an elongated dissecting member (Ans. 3-4).

Appellants contend that Chen does not teach a dissection tool having an elongated dissecting member (App. Br. 8).

The issue is: Does Chen disclose a dissection tool having an elongated dissecting member.

FINDINGS OF FACT

According to the Examiner:

1. “Chen discloses … a dissection tool comprising a handle (236), an arcuate shaped elongated dissection member (262), a battery (abstract: 8-6), a switch, and a light source (234), comprising a LED (abstract: 4-5) and a power line.” (Ans. 3; Chen, col. 24, l. 20.)
2. “Chen further discloses 2 fluid-channels (254) and (258) adapted to transport an irrigation fluid and a pharmaceutical (antibiotic) agent (8:27-34 and 9:47-51) shown in Fig 17.” (*Id.*)
3. Chen discloses that the positioning of the light source comprises the step of invasively disposing the light source proximate to the in vivo treatment site inside a patient’s body. (Col. 4, ll. 17-23.) Invasively disposing the source includes causing a penetration of the patient’s body to access an internal, in vivo treatment site. (Col. 4, ll. 23-30.)
4. Chen’s device provides for destruction of other abnormal cell types, destruction of normal cell types for therapeutic ends, and the destruction of microorganisms. (Col. 3, ll. 28-35.)
5. Dissecting means ““dividing or separating parts of an animal.”” (Ans. 4.) See also, (“to cut apart or separate (tissue).” Webster’s II New Riverside Dictionary, The Riverside Publishing Co, Boston, MA (1994).
6. The Specification, page 4 states that the dissector of the invention is suited to dissect a path for subcutaneous electrode placement.
7. The Specification, page 10, lines 22-26, states that the distal end of the tunneling tool projects light for improved navigation. The tool can be used to perform small diameter blunt tissue dissection of subdermal layers. (Spec. 11: 3-11.) Thus the tunneling tool is a dissecting member.

PRINCIPLES OF LAW

The standard under § 102 is one of strict identity. “Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). “Every element of the claimed invention must be literally present, arranged as in the claim.” *Richardson v. Suzuki Motor Co., Ltd* , 868 F.2d 1226, 1236 (Fed. Cir. 1989).

ANALYSIS

Appellants contend that “the Examiner has not identified where Chen teaches that flexible catheter 262 is a dissecting member, as claimed.” (App. Br. 8.)

The Examiner argues that according to a medical dictionary definition of the term “dissecting,” it is defined as “dividing or separating parts of an animal.” (Ans. 4.) The Examiner finds that Chen teaches in figures 2A-C the separation of tissue. (Ans. 4.)

We find that the use of Chen’s device (FF 3-5) is consistent with the tunneling and path dissection uses of the device claimed. (FF 6-7.) In particular, Chen’s Fig. 7 shows a ceramic tube having a pointed end which would be capable of tunneling through soft tissue and thus would serve as a dissecting member. (Chen, col. 6, ll. 9-18.) The light source may be invasively disposed proximate to the internal, in vivo treatment site. (Chen, col. 4, ll. 16-29.) The light source is invasively disposed by a step of causing penetration at the treatment site. (FF3, Chen, col. 4, ll. 25-29.) Moreover, according to Chen, the device is implantable which reasonably appears to support that the device of Chen, including array element 54, may be

tunneled and implanted in tissue, thus dissecting it. (Chen, abstract.) We agree with the Examiner that “whether or not another device is used to break the skin is irrelevant because the device of Chen is advanced through soft tissue thereby dissecting it.” (Ans. 4.)

Appellants argue that the Examiner improperly resorted to a dictionary instead of the Specification to define the term “dissect” and that according to the Specification the “dissecting member is used to perform small diameter blunt tissue dissection of subdermal layers and, for example, may be a long metal rod similar to conventional trocars.” (Reply Br. 8-9.)

We note that Appellants have not claimed a long metal rod dissecting member or that the dissecting member is a conventional trocar. The claim recites that the dissection tool includes an elongated dissecting member.

The Examiner argues that “[t]he device of Chen is inherently capable of being pushed through soft tissue because Chen discloses it may be made from PMMA [polymethylmethacrylate] a known flexible yet resilient material. Furthermore Chen discloses that the device can be stiffened if desired (column 19 line 17).” (Ans. 4.) We find the Examiner has the better argument, as the Appellants have not shown that the PMMA device of Chen is not capable of being pushed through soft tissue.

Appellants also argue that Chen fails to disclose a light source visible through the skin. (App. Br. 10.) However, Chen clearly discloses the use of both a LED and infrared light sources throughout its disclosure (Chen, abstract). For example in claims 21-23 of Chen he clearly is claiming the use of a LED or an infrared light sources.” (Ans. 4.) According to Appellants’ Specification page 13, the light source may be an LED light source. Appellants have put forth no argument indicating why his LED light

source is visible through the skin, and why the same LED light source of Chen, is not visible through the skin.

Appellants further argue that Chen fails to disclose a dissecting member extending from a handle. (App. Br. 10.) However, Chen discloses a syringe element 236 in Figures 16 and 17 which functions as a handle with flexible catheter 241 extending from it, Figure 16. (Ans. 5.)

Appellants argue that dependent claims are also improperly rejected over Chen arguing they recite additional features. (App. Br. 11.) However, merely stating the different limitations of dependent claims does not constitute separate argument. See 37 CFR 1.192(c)(7); *In re Dance*, 160 F.3d 1339, 1340 n.2, (Fed. Cir. 1998).

CONCLUSION OF LAW

In view of the above, we find that Chen teaches a dissection tool having an elongated dissecting member. Appellants have failed to rebut the Examiner's prima facie case of anticipation and the anticipation rejection is affirmed.

SUMMARY

The anticipation rejection over Chen is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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